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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,412	02/13/2001	Gary P. Mousseau	1400-1072 D5	3123
54120 7590 03/16/2011 RESEARCH IN MOTION ATTN: GLENDA WOLFE BUILDING 6, BRAZOS EAST, SUITE 100 5000 RIVERSIDE DRIVE IRVING, TX 75039			EXAMINER STRANGE, AARON N	
			ART UNIT 2448	PAPER NUMBER
			NOTIFICATION DATE 03/16/2011	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

[portfolioprossecution@rim.com](mailto:portfolioprossecution@rim.com)



# Office Action Summary

**Application No.**

09/782,412

**Applicant(s)**

MOUSSEAU ET AL.

**Examiner**

AARON STRANGE

**Art Unit**

2448

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 65-78 and 97-107 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 65-78 and 97-107 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF-06)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s) Mail Date \_\_\_\_\_



## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/29/2010 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 4/29/2100 have been fully considered but they are not persuasive.

3. With regard to claim 65, and Applicant's assertion that Eggleston fails to teach or suggest "maintaining a preferred sender list that can be selectively enable by a command from the mobile client" (Remarks 15-16), the Examiner respectfully disagrees. As an initial matter, it is noted that the current claims merely require processing a configuration command "operating to enable a preferred sender list with respect to the user". This language does not require a preexisting filter on the server that is enabled via the command. The broadest reasonable interpretation of the claim language would include a command that creates a "preferred sender list".



Nonetheless, Eggleston teaches both creation of a preferred sender list as well as enabling/disabling a preexisting preferred sender list. As acknowledged by Applicant (Remarks 15-16), Eggleston teaches client side creation of various filter settings (col. 9, ll. 47-52), including filters that permit messages from preferred senders to be forwarded (col. 8, ll. 23-29). Messages that satisfy these filters are determined to be on the "preferred sender list" (e.g., all messages from "Boss") (col. 8, ll. 28-29) and permitted to be forwarded.

Eggleston also teaches permitting a user to locally enable or disable groups of preexisting filters (col. 9, ll. 37-43) by establishing profiles associated with the filter settings. This would have allowed the user to enable a particular preferred sender list based on the profile selected by a user, such as a sender list permitting messages only from important senders while a user is in an important meeting.

Therefore, Eggleston teaches receiving a configuration command (e.g., download settings or a profile selection) from the mobile data device (settings can be entered at the mobile device and sent to the server)(col. 47-52), the configuration command operating to enable a preferred sender list with respect to the user (filter settings can specify particular senders whose messages will be forwarded)(col. 8, ll. 23-29), and determining that a received data item is from a sender (e.g., "Boss") on the preferred sender list before forwarding it (col. 8, ll. 28-29).



***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).



5. Claims 65 and 97 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 7, 10 and 16 of U.S. Patent No. 7,509,376. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim the principal features of common addressing using an outer envelope and piecemeal delivery of messages.

Claims 65 and 97 of the present application additionally include configuration of a preferred sender list, which is known in the art and taught by Eggleston (see rejection of claim 65, below).

Since both claim sets claim substantially the same invention, and the differences between them are old and well known, the claims are not patentably distinct and are rejected on the ground of nonstatutory obviousness-type double patenting.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 97-107 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Regarding claim 97, the claim elements "means for processing a configuration command", "means for processing a data item", "means for determining", "means for



repackaging", "means for processing a first command message" and "means for redirecting", are each means (or step) plus function limitations that invoke 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for each of the claimed functions.

The specification appears to describe each of the functions performed by these means as being performed by "redirector software 12" (See e.g., pp. 12-15) which is "operating at the user's PC" (see ¶26 of the specification amendment filed 5/16/2008) or at the "server 11" (see ¶40 of the specification amendment filed 5/16/2008).

The specification discloses only a "general purpose computer" (the user's PC or server 11) running a "redirector program", without including a description of the algorithm that transforms the general purpose computer into a special purpose computer programmed to perform each of the claimed functions. Applicant must disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the disclosed algorithm that performs the claimed function. *See Aristocrat Technologies, Inc. v. International Game Technology*, 521 F.3d 1328, 1338 (Fed. Cir. 2008). Applicant may express the algorithm in any understandable terms including a mathematical formula, in prose, in a flow chart, or in any other manner that provides sufficient structure. *See Finisar Corp. v. The DIRECTV Group Inc.*, 523 F.3d 1323, 1340 (Fed Cir. 2008).

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or



(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function (i.e., the algorithm that the general purpose computer executes to perform the claimed functions) without introducing any new matter (35 U.S.C. 132(a)) or relying on documents incorporated by reference.

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function (i.e., the algorithm that the general purpose computer executes to perform the claimed functions) and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function (i.e., identify the algorithm that the general purpose computer executes to perform the claimed functions). For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

9. All claims not individually rejected are rejected by virtue of their dependency from the above claims.



***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 65, 67-70, 89, 97 and 99 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Hall et al. (US 5,826,023).

12. With regard to independent claim 65, Eggleston disclosed a method of redirecting e-mail messages and message attachments to a user of a mobile data communication device that is associated with a host system and communicates therewith, the method comprising:

receiving a configuration command (e.g., download settings or a profile selection) from the mobile data communication device (settings can be entered at the mobile device and sent to the server)(col. 47-52), the configuration command operating to enable a preferred sender list with respect to the user (filter settings can specify particular senders whose messages will be forwarded)(col. 8, ll. 23-29);

receiving a data item (email) for the user at the host system (server 115) from a sender, the data item including a message attachment (email message with attachment)(col. 8, ll. 30-37) and an e-mail message addressed to a first address



identifying a mailbox that is viewable by the user (mailbox is user's personal email post office box)(col. 6, ll. 59-6);

determining that a received data item is from a sender (e.g., "Boss") on the preferred sender list (col. 8, ll. 28-29)

redirecting at least a portion (when the user has implemented a filter and only part of the message is sent to the user)(col. 3, ll. 23-26 and col. 10, ll. 10-32) of the e-mail message to a second address (wireless network address) associated with the mobile data communication device via a wireless network (messages, or portions thereof, are sent to the remote device at the network address of the device)(col. 4, ll. 29-35);

receiving a first command message from the mobile data communication device at the host system requesting more of the data item (sends the request after receiving partial or summary data for more of the message or all of the message)(col. 3, ll. 29-34 or col. 10, l. 57 to col. 11, l. 4); and

redirecting the message attachment from the host system to the mobile data communication device via the wireless network in response to first command message (when the user requests all of the message or full transfer of the message, the attachment will also be sent to the user's mobile device)(col. 3, ll. 29-34 or col. 10, ll. 57 to col. 11, l. 4).

However, Eggleston fails to specifically disclose that the message is redirected in an outer envelope for transmission via the wireless network, a technique known in the art as tunneling.



Hall discloses a similar system for transporting an electronic mail message across different network types (Abstract). Hall teaches encapsulating an electronic mail created for transmission via a first network in outer envelopes for transmission over a second type of network (col. 2, l. 45 to col. 3, l. 8). This would have been an advantageous addition to the system disclosed by Eggleston since it would have allowed the e-mail and reply messages to be created in the same format and simply tunneled over the wireless network using an outer envelope. This would have advantageously eliminated the need to convert messages between formats used by different networks.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to transmit the messages over the wireless network using an outer envelope to eliminate the need to convert message formats for communication over different network types.

13. With regard to claim 67, Eggleston disclosed:

configuring one or more redirection events at the host system (e.g. user sets up a filter, see inter alia Col 8, lines 14-55);

detecting that a redirection event has occurred at the host system (i.e. an email passes the filter criteria) and generating a redirection trigger (required internally in the system such that the system invokes the process or procedure to actually forward the message); and



In response to the redirection trigger, redirecting at least a portion of the e-mail message from the host system to the mobile data communication device (i.e. forwarding the message when it passes the filter criteria).

14. With regard to claims 68 and 69, Eggleston disclosed the external redirection event is a message from the mobile data communication device to start the redirection step (i.e. user enables the filters from the mobile device, Col 9, lines 32-43). Eggleston also disclosed the internal event includes a calendar alarm (calendar activates a filter profile, Col 9, lines 42-43).

15. With regard to claim 70, Eggleston disclosed the mobile data communication device is one of a hand-held wireless paging computer, a wirelessly-enabled palm-top computer, a mobile telephone with data message capabilities and a wirelessly-enabled laptop computer (Col 4, lines 11-13).

16. Claims 97 and 99 are rejected under the same rationale as claims 65 and 70, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.



17. Claims 71-73 and 100-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (US 5,958,006) in view of Hall et al. (US 5,826,023) further in view of Official Notice.

18. With regard to claims 71-73, while the system disclosed by Eggleston in view of Hall shows substantial features of the claimed invention (discussed above), it fails to disclose that the attachment is one of a word processing, audio or video attachment, or whether the attachment is one that can be processed by the mobile device.

The Examiner takes Official Notice that word processing files, audio files, and video files were all old and well known types of email attachments at the time the invention was made, and that word processing type files could be processed (displayed) by mobile devices while video files could not, due to limitations on processing capabilities at the time.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to permit these attachments to be received and processed by the system taught by Eggleston and Hall, since they were commonly accepted email attachments at the time the invention was made.

19. Claims 100-102 are rejected under the same rationale as claims 71-73, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.



20. Claims 66, 74-78, 98, and 103-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Eggleston et al. (US 5,958,006 in view of Hall et al. (US 5,826,023) further in view of Official Notice further in view of Kikinis (US 5,964,833).

21. With regard to claims 66 and 74, while the system disclosed by Eggleston and Hall shows substantial features of the claimed invention (discussed above), it fails to disclose receiving a second command message from the mobile data communication device at the host system to send the message attachment to an external device stored in a user profile and redirecting the message attachment from the host system to the external device in response to the second command message.

In a similar messaging system Kikinis disclosed a system that allows users to forward email attachments to various preprogrammed external devices such as a fax machine (Kikinis Col 4, lines 50-56). By allowing users to forward attachments using other devices rather than just email, Kikinis allows users to communicate easier and with more people. For instance an external device such a fax machine may be more convenient for some users or the only form of communication available to other users who are unable to receive email at a particular location.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Eggleston's system to allow users to forward attachments to other preprogrammed external devices, as disclosed by Kikinis, so that



users can communicate with other people by using different means rather than just email and thus communicate with more people.

22. With regard to claim 75, Kikinis disclosed the external device is one of a fax machine (Col 4, lines 50-56).

23. With regard to claim 76, Kikinis disclosed the step of decoupling the message attachment from the e-mail message (i.e. Kikinis only sends the attachment to a fax machine which requires decouple the message attachment from the e-mail message).

24. With regard to claims 77 and 78, Kikinis disclosed the step of storing the e-mail message and message attachment in a message store at the host system (Col 4, lines 38-48).

25. Claims 98 and 103-107 are rejected under the same rationale as claims 66, 74-78, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

### ***Conclusion***

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron Strange/  
Primary Examiner, Art Unit 2448